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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,819	07/28/2003	Walter L. Raines	Raines-003	5872
26604	7590	08/23/2004	EXAMINER	
KENNETH L. NASH P.O. BOX 680106 HOUSTON, TX 77268-0106			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER

3624

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,819	<b>Applicant(s)</b> RAINES, WALTER L.	
	<b>Examiner</b> Lalita M Hamilton	<b>Art Unit</b> 3624	



**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08182004</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to method of processing a plurality of credit card financial transactions, classified in class 705, subclass 35.
- II. Claims 22-24, drawn to system for processing credit card transactions, classified in class 705, subclass 40.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being used to process any store receipt. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kenneth Nash on August 16, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-24 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Specification***

The abstract of the disclosure is objected to because the use of "such as" is improper. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

Claim 1-11 are objected to because of the following informalities: In claims 1 and 7, "comprise" should be "comprises". The remaining claims are objected to because of their dependency on the objected claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-ambles and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a

technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Houvener (WO 00/75884).

Houvener discloses a receipt scanning method and corresponding system comprising producing a plurality of paper receipts related to said plurality of credit card financial transactions such that each of said plurality of paper receipts comprise machine-readable data which identify each of said plurality of credit card financial transactions, each of said plurality of paper receipts comprise an endorsement by a respective of said plurality of purchasers to confirm each of said plurality of credit card financial transactions, optically scanning each of said plurality of paper receipts for

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producing an electronic representation of said plurality of paper receipts including said endorsement and for reading said machine-readable data on said paper receipt, and electronically storing said electronic copy of said paper receipt so as to be organized for electronic retrieval based on said machine-readable data (p.9, 20 to p.10, 25); machine-readable data comprises bar codes (p.9, 20 to p.10, 25-inherent that machine-readable bar codes may be present on receipt, since many companies use bar codes to scan data into the system if a customer returns an item); machine-readable data comprises textual print readable by optical character recognition (OCR) software (p.9, 20 to p.10, 25); providing credit card transaction information over the Internet to said plurality of purchasers, said credit card transaction information comprising said electronic copy of said paper receipt (p.9, 20 to p.10, 25); printing said paper receipt with a printer operable for providing said machine-readable data on said paper receipt (p.9, 20 to p.10, 25); endorsement comprises a signature (p.9, 20 to p.10, 25); producing a plurality of receipts related to said plurality of credit card financial transactions such that each of said plurality of receipts comprise an endorsement by a respective of said plurality of purchasers to confirm each of said plurality of credit card financial transactions, electronically storing an electronic copy of each of said plurality of receipts, said electronic copy being suitable for producing a purchaser readable copy of a respective of said plurality of receipts, and providing a web site on the Internet accessible by said plurality of purchasers or agents thereof, said web site providing credit card transaction information regarding transactions made said plurality of purchasers during a selected time period, said web site being operable for providing

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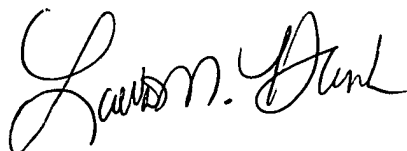
a viewable copy of said respective of said plurality of receipts for a selectable credit card transaction (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30); each of said plurality of receipts is a paper receipt (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30); each of said plurality of paper receipts comprise financial transaction data comprising items purchased (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30); said endorsement comprises a signature of each of said plurality of purchasers during a respective of said credit card financial transactions (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30); endorsement comprises a password known by a respective purchaser (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30--PIN); and a printer operable for producing a paper receipt related to said plurality of credit card financial transactions such that each of said plurality of paper receipts comprise machine-readable data which identify each of said plurality of credit card financial transactions, each of said plurality of paper receipts being endorsed by a respective of said plurality of purchasers to confirm each of said plurality of credit card financial transactions, an optical scanner for producing an electronic representation of said plurality of paper receipts including said endorsement, said optical scanner being operable for reading said machine-readable data on said paper receipt, an electronic storage medium for storing said electronic representation of said paper receipt, and a computer for organizing storage in said electronic storage based on said machine-readable data, said computer being operable for retrieving a selected electronic representation of said paper receipt based on said machine-readable data (p.9, 20 to p.10, 25 and p.16, 4 to p.17, 30).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LMH